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AUG 0 4 2008

In re Patent No. 7,201,016

HIROYUKI MARUYAMA : DECISION ON REQUEST FOR

Issue Date: April 10, 2007 : RECONSIDERATION OF

Application No. 10/776,168 : PATENT TERM ADJUSTMENT AND Filed: February 12, 2004 : NOTICE OF INTENT TO ISSUE Atty Docket No. 00862.023459 : CERTIFICATE OF CORRECTION

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM UNDER 37 CFR 1.705(d)" filed Monday, June 11, 2007. Patentee requests that the patent term adjustment for the above-identified patent be set at 527 days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of 485 days.

On April 10, 2007, the above-identified application matured into U.S. Patent No. 7,201,016. The instant request for reconsideration was timely filed on Monday, June 11, 2007. The patent issued with a revised Patent Term Adjustment of 369 days. Patentee states that the patent is not subject to any terminal disclaimer.

Patentee disputes the reduction of 38 days and 120 days pursuant to 37 CFR 1.704(c)(10) for filing a "Miscellaneous Incoming Letter" on June 5, 2006, and an Information Disclosure Statement (IDS) on July 14, 2006, respectively, after the mailing of the Notice of Allowance. Specifically, patentee asserts that these papers were filed to correct the official

record caused by errors on the part of the USPTO, and thus, should not be considered a failure to engage in reasonable efforts to conclude processing or examination of an application.

Pursuant to 37 CFR 1.704:

- (c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
 - (10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
 - (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
 - (ii) Four months

Furthermore, the OG Notice states that:

... the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the

Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001).

The record confirms that patentee filed a "LETTER REQUESTING CONSIDERATION OF PAPERS TIMELY FILED" on June 5, 2006, after the mailing of the Notice of Allowance. Nonetheless, under the circumstances, the filing of the "LETTER REQUESTING CONSIDERATION OF PAPERS TIMELY FILED" should not be considered a failure to engage in reasonable efforts to conclude processing or examination of an application and should not result in reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10).

The record shows that patentee submitted a priority document on May 7, 2004. In the Remarks section of the amendment filed April 20, 2006, patentee noted that the Examiner had not indicated that he had considered the submission of the priority document of May 7, 2004. Patentee requested that the Examiner indicate his consideration of the priority document in the next Office communication. Thereafter, on May 23, 2006, the Office mailed the Notice of Allowance and the Notice of Allowability, which did not contain an indication that the Examiner had considered the submission of the priority document. patentee attempted to have the Examiner address the issue Since the before the mailing of the Notice of Allowance. matter was not resolved at the time of the mailing of the Notice of Allowance, the next opportunity patentee had to raise this issue again was on June 5, 2006, by filing the "LETTER REQUESTING CONSIDERATION OF PAPERS TIMELY FILED." Accordingly, the reduction of 38 days is not warranted and is being removed.

¹ Palm records incorrectly indicate that patentee filed the "LETTER REQUESTING CONSIDERATION OF PAPERS TIMELY FILED" on June 6, 2006, instead of June 5, 2006.

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Patentee's argument that no reduction under 37 CFR 1.704(c)(10) should have been entered for filing the "REQUEST FOR NOTICE OF PUBLICATION," the "REQUEST FOR CITATION OF PATENT," and the IDS on July 14, 2006, after the mailing of the Notice of Allowance, is not well taken. These papers are not among the examples of the papers cited in the OG Notice, which do not cause substantial interference and delay in the patent issue process. Thus, the filing of the "REQUEST FOR NOTICE OF PUBLICATION," the "REQUEST FOR CITATION OF PATENT," and the IDS on July 14, 2006, after the mailing of the Notice of Allowance is a proper basis under 37 CFR 1.704(c)(10) for reduction of the period of adjustment. Unlike the circumstances surrounding the filing of "LETTER REQUESTING CONSIDERATION OF PAPERS TIMELY FILED" of June 5, 2006, patentee had other opportunities prior to the mailing of the Notice of Allowance to raise these matters but did not do so.

Nevertheless, the period of reduction under 37 CFR 1.704(c)(10) of 120 days for filing these papers is incorrect. The record reveals that the Office took action in response to the filing of these papers on August 3, 2006. Accordingly, the period of adjustment of the term of the patent should have been reduced by 21 days (not 120 days), the lesser period beginning on July 14, 2006, the date the "REQUEST FOR CITATION OF PATENT," the "REQUEST FOR NOTICE OF PUBLICATION," and the IDS were filed, and ending on August 3, 2006, the mailing date of the Supplemental Notice of Allowability.

Lastly, the record reveals that patentee filed a Supplemental Amendment on May 11, 2006, after filing a reply to the nonfinal Office action on April 20, 2006. The record does not support a conclusion that the Examiner expressly requested the filing of the Supplemental Amendment. Therefore, it is a proper basis for reduction of patent term pursuant to 37 CFR 1.704(c)(8). Accordingly, the period of adjustment of the term of the patent should be reduced by an additional 21 days, the number of days beginning on the day after the date the initial reply was filed, April 21, 2006, and ending on the date that the Supplemental Amendment was filed, May 11, 2006.

In view thereof, the patent term adjustment indicated in the patent should be 485 days.

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The \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 485 days.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Kery A. Fries

Senior Legal Advisor

Office of Patent Legal Administration

Office of Deputy Commissioner

for Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

PATENT

: 7,201,016

DATED

: April 10, 2007

INVENTOR(S): Maruyama

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

Subject to any disclaimer, the term of this patent is extended or adjusted [*] Notice: under 35 USC 154(b) by (369) days

Delete the phrase "by 369 days" and insert - by 485 days--



Day: Friday Date: 8/1/2008 Time: 14:03:46

PTA Calculations for Application: 10/776168								
Application Filing Date: 02/12/2004	PTO Delay (PTO):	527						
Issue Date of Patent: 04/10/2007	Three Years:	0						
Pre-Issue Petitions: 0	Applicant Delay (APPL):	158						
Post-Issue Petitions: 0	Total PTA (days):	485						
PTO Delay Adjustment: 116								

File Contents History								
Number	Date	Contents Description	PTO	APPL	START			
48	08/01/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	116					
44.5	03/21/2007	PTA 36 MONTHS						
44	04/10/2007	PATENT ISSUE DATE USED IN PTA CALCULATION	185		28			
43	01/11/2007	EXPORT TO FINAL DATA CAPTURE						
42	01/08/2007	DISPATCH TO FDC						
41	07/14/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED						
40		MAILING CORRECTED NOTICE OF ALLOWABILITY						
39	08/01/2006	CORRECTED NOTICE OF ALLOWABILITY						
37	07/14/2006	REFERENCE CAPTURE ON IDS						
36	07/14/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		120				
35	06/28/2006	EXPORT TO FINAL DATA CAPTURE						
34	06/23/2006	FINISHED INITIAL DATA CAPTURE						
33	06/23/2006	DISPATCH TO FDC						
32	06/13/2006	APPLICATION IS CONSIDERED READY FOR ISSUE						
31	06/06/2006	MISCELLANEOUS INCOMING LETTER		38				
30	06/13/2006	MAIL ACKNOWLEDGEMENT OF PRIORITY PAPERS						
29	06/12/2006	ACKNOWLEDGEMENT OF PRIORITY PAPERS						
28	06/07/2006	ISSUE FEE PAYMENT VERIFIED						
27	06/07/2006	ISSUE FEE PAYMENT RECEIVED						
26	05/26/2006	EXPORT TO INITIAL DATA CAPTURE						
25	05/23/2006	MAIL NOTICE OF ALLOWANCE						
24	05/18/2006	ISSUE REVISION COMPLETED						

23	05/18/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
22	05/18/2006	NOTICE OF ALLOWABILITY			
21	04/28/2006	DATE FORWARDED TO EXAMINER			
20	04/20/2006	RESPONSE AFTER NON-FINAL ACTION			
19	03/20/2006	MAIL NON-FINAL REJECTION	342		-1
18	03/17/2006	NON-FINAL REJECTION			
17	02/12/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
16	01/26/2006	ITEM TOO DEACHERS BY TECH CENTED			
15	02/12/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	·	CASE DOCKETED TO EXAMINER IN GAU			
13	12/09/2005	TRANSFER INQUIRY TO GAU			
12	03/30/2004	REFERENCE CAPTURE ON IDS			
11	03/30/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	05/07/2004	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
9 .		TRANSFER INQUIRY TO GAU			
8	05/07/2004	APPLICATION RETURN FROM OIPE		-	
7	05/07/2004	APPLICATION RETURN TO OIPE			
6	05/07/2004	APPLICATION DISPATCHED FROM OIPE			
5	05/07/2004	APPLICATION IS NOW COMPLETE			
4	03/22/2004	CLEARED BY OIPE CSR			
3	03/22/2004	CASE CLASSIFIED BY OIPE			
2	03/03/2004	IFW SCAN & PACR AUTO SECURITY REVIEW		<u> </u>	
1	02/12/2004	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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